

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte CLAUDE A. VIDAL, ALAN K. PLYLEY,  
RUSSELL J. REDMOND and ROGER LAGERQUIST

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Appeal No. 2003-1568  
Application No. 09/516,603

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ON BRIEF

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Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 8, 9, 16, 17, 25 to 32 and 34.<sup>1</sup> Claims 33 and 35 to 40 stand allowed. Claims 2 to 7, 14, 22 and 23 have been withdrawn from consideration. Claims 10 to 13, 15, 18 to 21 and 24 have been canceled.

We REVERSE.

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<sup>1</sup> Claim 25 was amended subsequent to the final rejection.

### BACKGROUND

The appellants' invention relates generally to jaw-type surgical instruments (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1, 8, 17, 25 to 32 and 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,978,049<sup>2</sup> to Green.

Claims 9 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Green.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 23, mailed October 1, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 21, filed August 19, 2002) and reply brief (Paper No. 24, filed December 9, 2002) for the appellants' arguments thereagainst.

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<sup>2</sup> Issued December 18, 1990.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The anticipation rejection**

We will not sustain the rejection of claims 1, 8, 17, 25 to 32 and 34 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The independent claims on appeal (i.e., claims 1, 25, 26, 27, 31 and 34) read as follows:

1. A surgical instrument with articulated jaw structure for capturing tissue of a body, the surgical instrument comprising:
  - a frame having a proximal end and a distal end, said frame defining an axial direction;
  - a first jaw having a proximal portion and a distal portion, the distal portion of the first jaw extending from the distal end of the frame;
  - a second jaw having a proximal portion and a distal portion, the distal portion of the second jaw extending from the distal end of the frame;
  - one of said first and second jaws having a staple cartridge for holding a plurality of staples adapted to be inserted in the tissue;
  - the proximal portions of the first and second jaws mounted to each other for movement in substantially parallel relation at least partially during movement between a fully open position wherein the distal portions of the jaws are separated for receiving tissue therebetween and an approximated position wherein the distal portions of the jaws are closer together for capturing said tissue, the jaws being in the fully open position when at least one of the jaws is moved distally with respect to the frame and being in the approximated position when at least one of the jaws is moved proximally with respect to the frame; and
  - an actuating mechanism including an actuating rod positioned within the frame, the actuating rod being connected to at least one of the jaws and being movable to move the jaws between the open and approximated positions.
  
25. A surgical instrument with articulated jaw structure for capturing tissue of a body, the surgical instrument comprising:
  - a frame having an outer end;
  - a first jaw having a proximal portion and a distal portion, the distal portion of the first jaw extending from the outer end of the frame;
  - a second jaw having a proximal portion and a distal portion, the distal portion of the second jaw extending from the outer end of the frame;
  - one of said first and second jaws adapted to receive a staple cartridge for holding a plurality of staples adapted to be inserted in the tissue;
  - the proximal portions of the first and second jaws mounted to each other for movement in a substantially parallel relation at least partially during movement between a fully open position wherein the distal portions of the jaws are separated for receiving tissue therebetween and an approximated position

wherein the distal portions of the jaws are closer together for capturing said tissue;

at least one of said jaws being further moveable between an extended position when the at least one of said jaws is moved distally with respect to the frame and the jaws are in one of the fully open and approximated positions, and a retracted position when at least one of said jaws is moved proximally with respect to the frame and the jaws are in the other of the fully open and approximated positions; and

an actuating mechanism connected to the at least one of said jaws, the actuating mechanism and the at least one of said jaws being axially movable to move the jaws between the open and approximated positions.

26. A endoscopic surgical instrument with articulated jaw structure, the surgical instrument comprising:

a handle portion;

an elongated endoscopic body portion extending distally from the handle portion and defining a longitudinal axis, the body portion being axially fixed with respect to the handle portion;

first and second jaw members connected to each other for movement between open and closed positions, and extending from a distal end of the elongated body portion, the first jaw member having a staple cartridge;

an actuating member connected to one of the first and second jaw members, the actuating member being movable to move at least one of the first and second jaw members axially to move the jaw members between the open and closed positions; and

wherein the jaw members are in the open position when the at least one of the jaw members and the actuating member are moved distally with respect to the elongated body portion and the jaw members are in the closed position when at least one of the jaw members and the actuating member are moved proximally with respect to the elongated body portion.

27. An endoscopic surgical instrument comprising:

a handle portion;

an endoscopic body portion fixed relative to the handle portion and defining a longitudinal axis; and

a pair of juxtaposed jaw members remotely actuatable from the handle portion and mounted for reciprocal longitudinal movement relative to the body portion and the handle portion between a first position wherein the jaws are in spaced relation and a second position wherein the jaws are in close relation, one

of said jaw members being adapted to receive a staple cartridge for supporting a plurality of staples.

31. A surgical instrument comprising:  
a handle portion;  
a body portion fixed to the handle portion and defining a longitudinal axis;  
a tool portion remotely actuable from the handle portion, the tool portion having an anvil jaw and a cartridge jaw containing a cartridge with staples, the cartridge jaw being mounted for reciprocal longitudinal movement relative to the body portion and handle portion between a first position wherein the jaws are in a closed position and a second position wherein the jaw members are in an open position;  
an actuating mechanism connected to the cartridge jaw, the actuating mechanism being movable to move the jaws between the open and the closed positions; and  
a firing mechanism actuable from the handle portion to fire the staples from the cartridge jaw when the jaws are in the closed position.

34. In a surgical instrument configured for capturing tissue, the surgical instrument including an elongated body portion extending distally from a handle portion and a distal tool portion supported by the elongated body portion and having a staple supply, the improvement comprising the distal tool portion having first and second jaw members extending from a distal end of the elongated body portion, one of the jaw members being adaptable to receive a staple cartridge, and an actuating portion connected to at least one of the jaw members and being longitudinally movable to cause longitudinal movement of the at least one jaw member with respect to the elongated body portion, wherein the jaw members open and close in response to the longitudinal movement.

Green's invention relates to surgical stapling apparatus, and more specifically to a drive member within a surgical stapler for driving a surgical staple into body tissue. Figure 7 is a perspective cut-away view of a surgical stapling apparatus including the staple drive member of Green's invention. Figure 7 shows a surgical stapling apparatus 510 which includes an endoscopic portion 512 and a handle portion 514. The

endoscopic portion is intended to be inserted into the body through a narrow diameter opening or tube, on the order of about 10 millimeters, with control of the stapling operation exercised by handle portion 514. Lower jaw 516 is fixed relative to endoscopic portion 512 and carries a cartridge 518 containing staples and staple drive members in accordance with Green's invention (shown in Figures 1-6). Upper jaw portion 520 is movably mounted, as by a hinge, relative to endoscopic portion 512 so as to be closable in the direction of arrow 522 toward lower jaw 516. In operation, lever handle 524 is closed in the direction of arrow 526 to advance collar 528 by appropriate mechanical advantage in the longitudinal direction of arrow 530 in order to close jaws 516, 520, clamping body tissue therebetween. Thereafter, handle 532 is longitudinally advanced in the direction of arrow 534 in order to advance drive bar 536 longitudinally through endoscopic portion 512. One or more pusher cams are connected to drive bar 536 and advance simultaneously therewith in the longitudinal direction relative to cartridge 518 in order to drive a plurality of three staple drive members constructed in accordance with Green's invention, thereby ejecting staples from the cartridge. The ejected staples penetrate through the body tissue and are formed closed against the anvil of upper jaw 520.

In the anticipation rejection before us in this appeal (answer, pp. 3-5), the examiner has read the claimed frame (claims 1 and 25) and the claimed handle portion

and body portion (claims 26, 27, 31 and 34) on Green's collar 528. In addition, the examiner has determined that Green's surgical stapling apparatus 510 is inherently capable of being moving in the manner claimed. In that regard, the examiner notes that by simply pulling axially on Green's handle portion 514 while lever handle 524 is pressed downward, the jaws 516, 520 would move into the frame (i.e., collar) 528 while the frame would be stationary.

The appellants argue throughout the briefs that the subject matter of claims 1, 25, 26, 27, 31 and 34 is not disclosed in Green. We agree.

With respect to claims 26, 27, 31 and 34, it is our view that the claimed handle portion and body portion are not readable on the proximal portion of Green's collar 528 and the distal portion of Green's collar 528 as asserted by the examiner. In that regard, it is our opinion that only handle portion 514 of Green's surgical stapling apparatus 510 would be considered to be a handle portion. Thus, Green's surgical stapling apparatus 510 is not inherently capable of being moving in the manner claimed (i.e., the jaws moving axially with respect to the handle portion and/or the body portion).

With respect to claims 1 and 25, it is our view that the claimed actuating mechanism connected to the at least one of said jaws (i.e., the jaw which is moved



distally with respect to the frame) wherein the actuating mechanism and the at least one of said jaws being axially movable to move the jaws between the open and approximated positions is not disclosed in Green. In that regard, we note that Green's endoscopic portion 512 is not able to be read on the claimed actuating mechanism since the endoscopic portion 512 to which lower jaw 516 is fixed and the upper jaw 516 is hinged must be read to be part of one of the claimed jaws so that the limitation that the first and second jaws are mounted to each other can be met. It is improper to read Green's endoscopic portion 512 as both a part of one of the claimed jaws and the claimed actuating mechanism.

Since all the limitations of independent claims 1, 25, 26, 27, 31 and 34 are not disclosed by Green for the reasons set forth above, the decision of the examiner to reject claims 1, 25, 26, 27, 31 and 34, and claims 8, 17 and 28 to 32 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

### **The obviousness rejection**

We will not sustain the rejection of dependent claims 9 and 16 under 35 U.S.C. § 103 since the examiner has not established that the subject matter of parent claim 1 would have been obvious at the time the invention was made to a person of ordinary skill in the art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 8, 17, 25 to 32 and 34 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 9 and 16 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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